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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,569	08/06/2001	Kenichi Sakuma	862.C2324	7063

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FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER	
RUHL, DENNIS WILLIAM	
ART UNIT	**PAPER NUMBER**
3629	

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/921,569	SAKUMA ET AL.	
	Examiner	Art Unit	
	Dennis Ruhl	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10/24/06*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-42* is/are pending in the application.

4a) Of the above claim(s) *6-8,14-16,18,24-26,32-34,36,38,40 and 42* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,9-13,17,19-23,27-31,35,37 and 39* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Applicant's election of 10/24/06 is noted. Applicant has elected to prosecute claims 1-5,9-13,17,19-23,27-31,35,37,39, and 41. Accordingly, claims 6-8,14-16,18,24-26,32-34,36,38,40 and 42 are withdrawn as being directed to a non-elected invention.

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 4,12,22,30,41, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claims 4,22, the examiner is not clear as to what the scope of the term "determination means" is. Applicant has claimed the calculation means as comprising determination means but it is not clear as to what corresponding structure form the specification is covered by this language. The examiner feels that in this case claiming a means as having another means renders the claim indefinite because the scope of the two means limitations are not clear.

For claims 12,30, it is not clear as to under what conditions the estimate information with new product information is transmitted. The claim recites that this is done on the basis of the determination step but it is not recited what the basis is. If the determination step results in the finding that the estimate is "not more than a predetermined value", what happens next? Is the estimate sent out? The examiner is not clear as to whether or not the estimate is even being sent out because it seems to

depend on the result of the determination step. There is also no antecedent basis for "the determination step" as none appears to have been previously claimed.

For claim 41, it is not clear if this claim is directed to a computer readable memory or if the claim is directed to a method. The body of the claim is only reciting method steps which indicate that the claim is a method. This contradicts the preamble that seems to imply that the claim is directed to a computer readable memory storing a program. It is not clear as to what statutory class of invention this claim falls into. The scope of the claim is indefinite. It is also not really clear as to whether or not there is even a notification being sent. What if the estimate is less that some predetermined value? Does that mean that the notification step does not occur? If that is true then is the scope of the claim only requiring the calculation step and nothing more? Or is the scope of the claim such that the notification will only contain information about a new product, with no estimate because the estimate is less than the predetermined value? The scope of this claim is not clear.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-5,19-23,35,37,41, are rejected under 35 U.S.C. 102e as being anticipated by Li (6609050)

For claims 1,19,35, Li discloses a system as claimed. Li discloses a system that allows a user to transmit fault information as claimed. Le discloses a terminal 80, server 10, and network 21. The first transmission means is interpreted to be the hardware/software of terminal 80 that allows data transmission to occur. The 2nd transmission means is the hardware/software of the server 10 that allows data transmission to occur from the server to the user terminal. See column 8, lines 21-23 for the disclosure of the calculation means. With respect to the claim language that is reciting the kind of data that is intended to be transmitted, this is directed to the intended use of the system and is not taken to be a recitation that is further reciting any structure to the system claim.

For claims 2,20, the calculation means is disclosed as determining a repair estimate as claimed. This takes into account any possible warranty that may be valid at the time. If the warranty covers the repair, then there is no cost to the customer, and if the warranty is no longer valid, a monetary repair estimate is calculated.

For claims 3,5,21,23, these claims are directed to the content of the estimate and are considered to be non-functional descriptive material. The estimate is not a structural part of the recited system so any recitations directed to what the estimate contains are not reciting any further structure to the system. However, Li does teach that calculation of how long a particular repair will be made and this appears to satisfy what has been claimed for claim 3, if the limitation were to be given patentable weight. Because the estimate is something that the system creates and is not part of the system, these recitations are not patentably distinguishing features.

For claims 4,22, as best understood by the examiner, Li discloses what is claimed. The 2nd paragraph of the claim is directed to a method of use (method step) and is not reciting any further structure to the system.

For claim 37, Li discloses calculations means as was previously addressed. The notification means is interpreted to be the hardware/software that allows for the transmission of information from the server to the terminal. The recitation of what the notification contains (what it says), is not a part of the apparatus and is directed to the intended use of the system. The notification itself is not part of the apparatus, so recitations directed to what the notification contains are not reciting any further structure to the apparatus itself.

For claim 41, as the claims is best understood by the examiner, Li discloses the calculation of an estimate. Li then inherently is sending information about a new product. If your brakes are not working, the estimate will include information about new brakes, which constitutes a new product for the vehicle that needs repair.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 9-13,17,27-31,39, are rejected under 35 U.S.C. 103(a) as being unpatentable over Li in view of "The car that called for help", (1/2000)

For claims 9,17,27, Li discloses a method as claimed. Li discloses the steps of transmitting failure information (automotive information) to the server 10. Li also discloses the step of calculating an estimate as claimed. The estimate is then sent back to the terminal from the server as claimed. Li does not disclose that the information that is transmitted from the terminal to the server concerns equipment that is connected to the terminal. In Li the terminals is not in the car and are not connected to the car. In "The car that called for help" article, it is disclosed that vehicles contain computers that

transmit fault information (concerning equipment in the vehicle) to a service center. This article teaches the desirability of having terminals in vehicles themselves to make the transmission of service information easier and more customer friendly. It would have been obvious to one of ordinary skill in the art at the time the invention was made to put the system of Li into a vehicle so that the system can monitor the vehicle for faults so that any service information can be transmitted to the service server as claimed, as is disclosed by the article.

For claims 10,28, the calculation means is disclosed as determining a repair estimate as claimed. This takes into account any possible warranty that may be valid at the time. If the warranty covers the repair, then there is no cost to the customer, and if the warranty is no longer valid, a monetary repair estimate is calculated.

For claim 11,29, the estimate includes dates of when to drop off and pick up, and this satisfies what has been claimed.

For claim 12,30,39, not disclosed is the step of determining whether or not the estimate is "not more than a predetermined value". It is well known that in the event a vehicle is damaged and the money it would cost to repair that vehicle is more than the vehicle is worth, the vehicle is considered a total loss. If your vehicle needs $5000 of repairs and the value of the vehicle is only $1000, it does not make financial sense to repair the vehicle. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the customer with information about a new/used vehicle for sale, in the event that the repair estimate is determined to have a value higher than the worth of the vehicle itself. This would be advantageous for both the

customer and service center because customer could potentially save money in repairs and the service center could sell the customer a vehicle.

For claims 13,31, applicant has recited that the estimate includes a URL. The scope of the language of this claim allows for the URL to be simply text, and because the method does not use the URL in any manner, the examiner has interpreted this limitation to be akin to printed matter and is not a patentably distinguishing feature.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. "Reynolds and Reynolds Adds Wireless Capability.....in Networkcar", Sharood et al. (6453687), Cherrington et al. (6070155), Wilson et al. (6662091), Lightner et al. (6732031), and McGuire et al. (4404639).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DENNIS RUHL
PRIMARY EXAMINER